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Assistant Commissioner for Patents
Washington, D.C. 20231

ATTORNEY DOCKET NO. 023070-087910US

PATENT

On May 28, 2002
TOWNSEND and TOWNSEND and CREW LLP
By: Wishia Newell

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JUL 25 2002

TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

ROSE et al.

Application No.: 09/832,510

Filed: April 10, 2001

For: ANTIGENIC EPITOPES WITH
LYM-1 REACTIVITY AND USES
THEREOF

Examiner: Huff, Sheela Jitendra

Art Unit: 1642

RESPONSE TO RESTRICTION
REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants respond herein to the Restriction Requirement mailed April 26, 2002 (the "Requirement"). No fees are believed to be due in connection with this Response; if, however, any fees are in fact due, the Commissioner is authorized to deduct them from Deposit Account 20-1430.

Applicants hereby elect Group I, claims 7-18, with traverse.

Applicants traverse the restriction. The Requirement states that two inventions are unrelated if it can be shown that they have different modes of operation, different functions, or different effects. The Requirement, however, does not show any of these things. It merely makes conclusory statements that the groups "are directed to different methods and involve the use of different reagents and have different steps." Applicants respectfully observe that these conclusory statements do not make a *prima facie* case that the methods have different modes of operation, different functions, or different effects. The fact that two methods may use different reagents, or have different steps, says nothing at all about the modes of operation, functions or effects of the methods. PCR, for example, would still seem to be conducted to amplify target nucleic

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acids whether the reagent used is *Taq* polymerase or a polymerase isolated from another thermophile. The fact that two methods have different results is not to be expected, since otherwise the methods would be the same. It does not follow that the methods have different operations, functions, or effects.

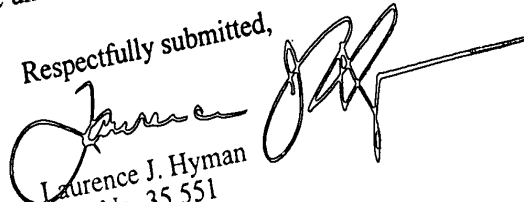
While the foregoing is sufficient to show that the requirements of 35 U.S.C. § 103 are not met, it is also deficient because it fails to show that there would be a serious burden on the Examiner to examine the claims together. MPEP § 803 requires examiners to examine claims together unless to do so would impose a serious burden on the examiner. The Requirement fails even to allege, let alone to show, that examining all the claims together in this application would impose a serious burden on the Examiner.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,


Laurence J. Hyman
Reg. No. 35,551

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U.S. Patent and Trademark Office
Washington, DC 20231

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JUL 25 2002

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On July 16, 2002
TOWNSEND and TOWNSEND and CREW LLP
By: Patricia A. Anderson

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

ROSE *et al.*

Application No.: 09/832,510

Filed: April 10, 2001

For: ANTIGENIC EPITOPES WITH
LYM-1 REACTIVITY AND USES
THEREOF

Examiner: Huff, Sheela Jitendra

Art Unit: 1642

SUPPLEMENTAL AMENDMENT

U.S. Patent and Trademark Office
Washington DC 20231

Sir:

Applicants respond herein to the Official Communication dated June 17, 2002. The June 17 Communication concerns two matters. First, it states that the Applicants Communication dated May 28, 2002 did not respond to the Restriction Requirement imposed by the April 26, 2002, Office Action. Second, it indicates that Applicants' Communication dated May 28, 2002, responding to the Notice to Comply with the Sequence Listing Requirements that accompanied the April 26 Office Action amended claims that were canceled, as well as those pending in the proceeding. The June 17 Official Communication therefore indicated that only the amendments to the specification had been entered and requested that Applicants review which claims were intended to be pursued in this proceeding.

In a phone message left for the Examiner on June 24, 2002, the undersigned counsel responded to both concerns raised in the June 17 Communication. First, counsel pointed out the Applicants had indeed responded to the Restriction Requirement, in a separate paper mailed concurrently with the Communication under 37 C.F.R. 1.821 et al. Applicants counsel pointed out that the Transmittal Form PTO/SB/21 for each paper noted in the "Remarks" section that the other paper was being mailed concurrently, and that this procedure had been adopted in an attempt to comply with the Office's requirement to address sequence listings to "Box Sequence". Applicants' counsel further noted in his June 24 message that he assumed the response to the Restriction Response had reached the Examiner after the mailing of the Official Communication of June 17. For the Examiner's convenience, however, a further copy of the May 28, 2002 response to the restriction requirement, showing the certificate of mailing, is attached hereto.

In the phone message, Applicants' counsel also indicated that the Applicants' May 28 Communication had amended all the claims simply to be in compliance with the Notice to Comply and that there was no confusion over the claims pending. Since the June 17 Official Communication, however, indicates that the amendments to the claims requested by the Applicants' May 28 Amendment were not entered, for the sake of good order, Applicants hereby amend the pending claims in this amendment.

Please amend the application as follows.

In the Claims:

Please amend claims 9, 17, and 21 as follows:

C¹
9. (Amended) The method of claim 7, wherein the subsequence encodes a peptide wherein R₁ is Gln, Lys, or Arg; R₂ is Arg; R₃ is Arg; R₄ is Ala; R₅ is Ala; R₆ is Val; R₇ is Asp; R₈ is Thr; R₉ is Tyr; R₁₀ is Cys; R₁₁ is Arg; R₁₂ is His; R₁₃ is Asn; R₁₄ is Tyr; R₁₅ is Gly, and R₁₆ is Val (SEQ ID NO:2).